

## **REMARKS/ARGUMENTS**

Upon careful and complete consideration of the Office Action dated August 26, 2003, applicants have amended the claims which, when considered in conjunction with the comments herein below, are deemed to place the present application into condition for allowance. Favorable reconsideration of this application, as amended, is respectfully solicited.

In the present Office Action, the Examiner has withdrawn claims 1-11 and 17 and considered orally elected, with traverse, group III claims 12-16. Claims 14 and 16 have been rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite. Claims 12-16 have been rejected under 35 U.S.C. §102(b) as allegedly anticipated by or, alternatively, under 35 U.S.C. §103(a) as allegedly obvious over European Patent 0415069 (EP '069).

This response addresses the restriction requirement and each of the rejections. Applicants have redrafted the claims to expedite favorable prosecution. No new matter has been added by this amendment. Support for the current amendment can be found throughout the specification, e.g., at page 16, lines 28-30.

Originally filed claims 1-17 have been subjected to restriction by the Examiner under 35 U.S.C. §121 as follows:

- I. Claims 1-10 drawn to condensation of polyamides, classified in classes 525 and 528, subclass various.
- II. Claims 11 and 17 drawn to a method of use, classified in class 525, subclass various.
- III. Claims 12-16, drawn to an additive, classified in classes 525 and 528, subclass various.

Pursuant to 37 C.F.R. §§1.111 and 1.143, applicants hereby provisionally elect the invention of group III, claims 12-16; traverse the Examiner's requirement for restriction and request reconsideration thereof in view of the following remarks.

In support of the present restriction requirement, the Examiner has alleged that the subject matter defined by the claims of the present invention represents three separate and distinct inventions. The Examiner alleged that inventions of groups II and III are related as mutually exclusive species in an intermediate-final product relationship and patentably distinct and that inventions of groups II and III are unrelated.

It is respectfully submitted that the Office Action must satisfy two criteria in substantiating a proper restriction of the claims of an application. First, it must be shown that the application claims are independent and distinct inventions, as required by both 35 U.S.C. §121 and the 37 C.F.R. §§1.141, 1.142 and 1.499. Second, it must be shown that examining all claimed inventions in a single application would constitute a serious burden. MPEP §803. The Examiner has failed to demonstrate either of the above. If the Examiner cannot substantiate distinctiveness, she has to examine the product claims, its process of making and method of use claims together.

An Examiner's authority to require restriction is defined and limited by statute:

If two or more **independent and distinct** inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. 35 U.S.C. §121, first sentence (emphasis added).

The implementing regulations of the Patent and Trademark Office include the mandate that restriction is appropriate only in cases presenting inventions which are both independent and distinct, 37 C.F.R. §§1.141-142. Without a showing of independence and distinctness, a restriction requirement is unauthorized.

In the present application, the claims which the Examiner has grouped separately are not “independent and distinct” so as to justify the restriction requirement. Applicant submits that the application relates to one inventive concept and that the entire application should be examined together. The application teaches additives for the process of condensation of oligo or polyamides and polycarbonates, use of these additives in the process of condensation and compatibilization of oligo or polyamides and polycarbonates. Accordingly, the inventions of groups I-III are very clearly interrelated and interdependent, not “independent and distinct”.

Only the statutory requirement that Groups II and III are “distinct” and Groups I and II are “independent” has been proffered as a basis for requiring the restriction. Even assuming, pro arguendo, that the Office Action was correct with respect to the distinctness of Groups II and III and the independentness of Groups I and II, there is absolutely no indication in the Office Action that the claims of Group II and II are also independent and that the claims of Group I and II are also distinct.

In addition, the courts have recognized that it is in the public interest to permit applicants to claim several aspects of their invention together in one application, as the applicant have done herein. The CCPA has observed:

We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. §112 all aspects as to what they regard as their invention, regardless of the number of statutory classes involved.

In re Kuehl, 456 F.2d 658, 666, 117 U.S.P.Q. 250, 256 (CCPA 1973). This interest is consistent with the practical reality that a sufficiently detailed disclosure supporting claims to one aspect of an invention customarily is sufficient to support claims in the same application to other aspects of the invention.

Applicants respectfully suggest that in view of the continued increase of official fees and the potential limitation of an applicant’s financial resources, a practice which

arbitrarily imposes three-way restriction requirements may become prohibitive and thereby contravene the constitutional purpose to promote and encourage the progress of science and the useful arts. Moreover, under the regulatory changes as a consequence of the implementation of the General Agreement on Trade and Tariffs (GATT), applicants are required either to conduct simultaneous prosecution, as here requiring excessive filing costs, or otherwise compromise the term of their patent assets.

It is vital to all applicants that restriction requirements issue only with the proper statutory authorization, because patents issuing on divisional applications filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double patenting. The third sentence of 35 U.S.C. §121, which states that a patent issuing on a parent application “shall not be used as a reference” against a divisional application or a patent issued thereon, does not provide comfort to applicants against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that §121 protects a patentee from an allegation of same-invention double patenting, Studiengesellschaft Kohle mbH v. Northern Petrochemical Co., 784 F.2d 351, 355, 288 U.S.P.Q. 837, 840 (Fed. Cir. 1986); and in Gerber Garment Technology Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990) that court held that §121 does not insulate a patentee from an allegation of “obviousness-type” double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of a patent on the divisional application.

All these considerations indicate that the imposition of a restriction requirement with inadequate authority can lead to situations in which an applicants’ legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect a patentee’s rights and to serve the public’s interest in the legitimacy of issued

patents, applicants respectfully urge the Examiner not to require restriction in cases such as the present application wherein various aspects in a unitary invention are claimed.

The Examiner has justified the restriction requirement in this case by reference to the two classes of the Patent and Trademark Office classification system in which the three groups of claims would allegedly be classed. The Examiner has placed all inventions in class 525 and subclass various, and inventions I and III in class 528 also. Hence, these claims should be considered together as such. Thus, there is no basis for the restriction requirement in this application.

In addition, reliance on the classification of the groups of claims does not establish independence and distinctness. The classification system has no statutory recognition as evidence of whether inventions are independent and distinct. The classification system is instead an aid in finding and searching for patents.

The classification system is also an unreliable basis for requiring restriction between claims to the various aspects of applicants' unitary invention, because the system exhibits considerable overlap in technical definitions. In particular, the definitions of subclasses in the classification system do not prevent the Examiner from basing patentability decisions, as to claims assigned to one group, on patent references found in the subclass(es) with which the Examiner associated another group of claims.

Furthermore, the classification system is a poor basis for requiring restriction between related aspects of an invention because classifications and definitions change over time. Thus, a classification that might have seemed to support restriction at a given time could change, thereby casting a shadow over the propriety of the restriction requirement later on during the term of the patents issuing from parent and divisional applications. Indeed, classifications seem largely to change in response to considerations of administrative convenience, and often in response to nothing more than growth in the number of patents in a given class or subclass. These considerations have nothing to do with

whether the subject matter of patents assigned to different classifications is “independent and distinct” as those terms are used in 35 U.S.C. §121, which fact proves that basing restriction requirements on the classification system is improper.

Further, it is expected that the non-elected process claims will be rejoined when a product claim is found allowable as per the USPTO’s published official gazette notice entitled "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)."

In addition, Applicants would like to point out that corresponding patents have been granted in Germany and Japan by corresponding Patent Offices, without any restriction. The Russian Patent Office also has not raised any unity issues and it is expected that the patent will be granted in Russia soon.

In view of the foregoing comments, it is respectfully urged that the Examiner reconsider and withdraw the requirement for restriction.

Claims 14 and 16 have been rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite. Applicants have redrafted claims 14 and 16 as suggested by the Examiner to overcome this rejection, and respectfully request the Examiner to withdraw this rejection.

Claims 12-16 have been rejected under 35 U.S.C. §102(b) as allegedly anticipated or, alternatively, under 35 U.S.C. §103(a) as allegedly obvious over European Patent 0415069 (EP '069). The Examiner alleged that the polyamide of EP '069 fulfills the P segment in the instant claims; that the polyepoxy linking fulfills the L unit; and that the polycarbonate segment of EP '069 fulfills the CE<sup>1</sup> and CE<sup>2</sup> segments of the instant claims.

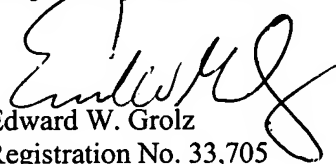
With regard to the rejection under §102(b), contrary to the Examiner's contention, the polyepoxy-linking agent in EP '069 is not the same as the linker L in the present invention. The EP '069 polymer comprises a block polymer formed by reacting a polyamide (a) and a thermoplastic carbonate polymer (b) in the presence of a polyepoxy

compound (c). The polyepoxy-linking agent (C) in the cited reference, such as triglycidyl isocyanurate, is a chemical reagent that joins by reaction of epoxy groups the two polymer (a) and (b) containing amino groups, carboxyl groups or ester groups and becomes part of the polymer. Moreover, the polyepoxy-linking agent (c) is distinguished by the need for at least two epoxy groups per molecule (see EP '069 at page 4, line 48) and does not anticipate L as defined by the present case. Moreover, the prior art does not teach the necessity of two carbonate components, while the present invention requires not only two carbonate units, but also that they be directly bonded to each other as shown in formula (I). Accordingly, EP '069 does not anticipate the present invention and Applicants respectfully request withdrawal of this rejection.

With regard to the rejection under §103, the mere fact that the cited reference allegedly contains an element that may fulfill the function of one of the elements in the present invention does not render the instant claims obvious, unless the cited art also suggests the desirability of such modification. EP '069 provides a polymer comprising a block copolymer formed by reacting a polyamide and a thermoplastic carbonate polymer in the presence of a polyepoxy-linking compound. EP '069 does not suggest or motivate a person of skill in the art to make the claimed additive in which two carbonate units are present adjacent to each other and directly bonded to each other. In order to expedite favorable prosecution, applicants have amended claim 12 and added new claim 18 to recite linkers  $-\text{COO}-$ ,  $-\text{CO}-$ ,  $-\text{O}-$ ,  $-\text{NR}-$ ,  $-\text{NHCOO}-$ ,  $-\text{NHCONH}-$ , and  $\text{N}(\text{COR})-$ , wherein R represents an alkyl or aryl group,  $-\text{CONH}-$  and  $-(\text{CH}_2)_n-$ , wherein n is 1-5. Support for the current amendment can be found throughout the specification, e.g., at page 16, lines 28-30. Hence, the present invention, as amended, is not obvious over the EP '069. Accordingly, applicants respectfully request withdrawal of this rejection.

Finally, it is further submitted that all the claims in the application as presently submitted contain patentable subject matter and a Notice of Allowance is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Edward W. Grolz', written over the printed name and registration number.

Edward W. Grolz  
Registration No. 33,705

SCULLY, SCOTT, MURPHY & PRESSER  
400 Garden City Plaza  
Garden City, New York 11530  
(516) 742-4343

EWG/nd